

REMARKS

1. The application was filed with Claims 1-29, and the Examiner required a restriction between Claims 1-22 and 23-29. Applicants elected Claims 1-22, and the Examiner required a further restriction as to Claims 20-22, as between a combination and a subcombination, and has withdrawn Claims 20-22 from consideration. Therefore Claims 1-19 are pending and Claims 20-29 have been withdrawn by the Examiner. Claims 1 and 14 have been amended.

The Examiner is thanked for finding allowable subject matter in Claims 9, 10, and 13, if they are rewritten in independent format with all the limitations of the base claim and any intervening claim. The Examiner is also thanked for withdrawing the previous rejections of claims over U.S. Pat. No. 6,367,949 to John C. Pederson and U.S. Pat. No. 6,124,886 to Jonathan DeLine et al. The Examiner has now rejected Claims 1-5 and 14-19 under 35 U.S.C. § 102(e) and has also rejected Claims 6-8, 11 and 12 under 35 U.S.C. § 103(a).

2. The Examiner's restriction in the present Office Action to Claims 1-19 is acknowledged, but traverse is maintained. The Examiner has required a restriction on the grounds that the subcombination (Claims 20-22) has utility by itself or in other combinations.

3. Claims 1-5 and 14-19 are rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Pat. No. 6,124,886 to Jonathan DeLine et al. ("DeLine"). The Examiner enumerates a number of components in DeLine and states that DeLine anticipates all the elements of Claims 1-5 and 14-19. The rearview mirror of DeLine does not anticipate the claimed invention. Applicants traverse the rejections under § 102(e). Applicants have also amended Claims 1 and 14 to better claim the invention described in the specification and not for reasons related to the patent laws.

One of the requirements of amended Claim 1 is "at least one control module mounted on said insulator and connected to said at least one conductor." A control module is defined in the specification of the present patent application as a module that acts "as a controller or power supply for the at least one lamp." Specification, p. 3, lines 5-6. The Examiner notes switch 72a and states that "the box housing the wiring connections associated with the switch is considered as a module." Office Action, p. 4 lines 18-19. The rearview mirror of DeLine, as cited by the Examiner, is portrayed in Figs. 1 and 4 and is described in col. 7. The word "box" does not appear in DeLine, and the only "box" structures apparent from the figures and description of DeLine are the switches 72a, 72b, 72c and 72d, and the rearview mirror case itself, numerals 12

and 18. A switch by itself is not a control module; and the entire assembly is not a “control module,” but is described as a “modular rearview mirror assembly.” Col. 7, lines 16-17. DeLine does not describe or suggest a “control module” as claimed in independent Claim 1 and dependent Claims 2-5. Accordingly, DeLine does not anticipate Claim 1. Nevertheless, Claim 1 has been amended to recite that the control module is adapted for controlling or supplying power to at least one lamp. This further serves to distinguish Claim 1 from DeLine.

Claim 14 claims “an integrated light and accessory assembly,” and one limitation of amended Claim 14 is “a housing, enclosing the insulator, the at least one reflector, the at least one conductor, the at least one lamp, and the at least one electronic module.” That is, the assembly is integrated by being placed into a housing. The Examiner enumerates components that allegedly anticipate elements of Claims 14-19. The Examiner states that DeLine discloses an integrated light and accessory assembly, as shown in Fig. 47 and described in the text of cols. 27-30. Applicants traverse the characterization of DeLine as “an integrated light and assembly accessory for a motor vehicle” as claimed in Claim 14. Fig. 47, and accompanying text, depicts not an integrated assembly, but an upper rearview mirror assembly in a first housing and also a second lower assembly in a second housing, with a number of modules, such as a tape recorder 519 that clearly require the same elements as the Examiner describes for the upper assembly. That is, Fig. 47 describes two assemblies to perform the same functions as the invention claimed in Claim 14 and its dependent claims, an integrated light and accessory assembly.

Thus, at least one limitation of Claims 1 and 14 is not present in the reference, that is, the disclosure of Fig. 47 does not provide an “integrated” light and accessory assembly. An invention is not anticipated when the same device or method, including all the limitations contained in the claims, is not described in a single prior art reference. M.P.E.P. 2131. In addition, elimination of an element, while retaining its function, is evidence of patentability. M.P.E.P. 2144.04. Applicants submit that the rejection under 35 U.S.C. § 102(e) is overcome, and respectfully request that the Examiner withdraw the rejections. Claim 14 has nevertheless been amended to correct antecedent basis and to better describe the functions of the module.

4. Claims 6-8, 11 and 12 are rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Pat. No. 6,124,886 to Jonathan DeLine et al. (“DeLine”). Dependent claims 6-8, 11 and 12 claim an integrated light and accessory assembly further comprising a device, such as an antenna, a sensor, a transmitter, or a functional module, that is mounted to the insulator. Claim 7

enumerates a number of sensors or cameras, and Claim 8 recites a number of transmitters. Claims 11 and 12 depend from Claim 1 and claim a functional module mounted to an additional conductor. Each of these claims depends from Claim 1 or from another claim depending from Claim 1, and thus requires the other limitations of Claim 1, as mentioned in the discussion for Claims 1 and 14 above. DeLine does not describe or suggest a "control module" as claimed in Claim 1. Therefore, Claims 6-8, 11 and 12 are patentable over DeLine.

As to Claims 6 and 7, the Examiner admits that DeLine does not teach a device mounted to the insulator of the first embodiment. Office Action, p. 6, lines 18-20. The Examiner then states that DeLine discloses a modular rear-view mirror with a first forward facing light sensor and a second rearward facing light sensor, and that it would have been obvious to modify the first embodiment by adding light sensors for benefits of size reduction and economical electronic packaging. The Examiner points to Figs. 30 and 31 of DeLine, which depict at least three layers (286, 288 and 20") used to provide support and insulation for the modular rear-view mirror.

Claims 6 and 7, depending from Claim 1, claim an integrated light and accessory assembly with a relatively small number of layers of insulators and conductors, so that the assembly is inexpensive to manufacture and assemble. It requires improper hindsight for the Examiner to pick a feature at a time from the prior art, such as the light sensors mentioned from Figs. 30 and 31, without also noting the many disadvantages of the prior art. The light sensors cited by the Examiner are used in a rearview mirror assembly that requires, as stated above, several extra layers of insulators and conductors not noted by the Examiner in citing the light sensors. The Examiner states that it would have been obvious to modify the rearview mirror of DeLine by adding light sensors; however, adding the light sensors of DeLine would also have added at least two layers of support as shown in Figs. 30 and 31 of DeLine. Therefore, without impermissible hindsight, the combination would not have yielded the invention claimed in Claims 6 and 7 of the present invention.

As to Claim 8, the Examiner states that DeLine teaches a modular rearview assembly comprising a transmitter 508l performing an automatic toll booth function, and that it would have been obvious to add a transmitter for the benefits and advantages of size reduction and economical electronic packaging. Office Action, p. 7, lines 13-17, citing Fig. 47.

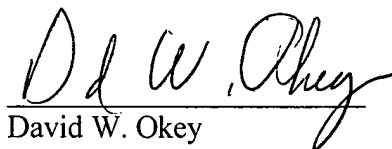
Fig. 47 belies the arguments, however. Fig. 47 does not suggest or describe size reduction and economical electronic packaging, but rather Fig. 47 teaches the use of two housings, case housing 502 and pod 506. Only with the aid of impermissible hindsight would

one combine the transmitter of DeLine's Fig. 47 to DeLine's first embodiment, resulting in two housings. Therefore, as mentioned above for Claim 1, DeLine does not teach an "integrated light and accessory assembly," in which the components are integrated, i.e., housed in a separate housing, and DeLine does not make Claim 8 unpatentable under 35 U.S.C. § 103(a).

Applicants also traverse the rejections of Claims 11 and 12, which further define the limitations of the claimed functional modules. As the Examiner admits, DeLine does not teach, per Claim 11, an additional functional module connected to an additional conductor mounted on the insulator (of Claim 1). Claim 12 claims the assembly of Claim 11, and lists a number of the functional modules, such as a video camera controller, a radar detector controller, and so on. As discussed above in the section on § 102(e) rejections, DeLine does teach other assemblies, such as Fig. 47, in which compactness, size reduction, and economical electrical packaging are not at all evident, because the assembly is contained in at least two housings, such as the "sixth embodiment" of Fig. 47. Therefore, as admitted by the Examiner, the reference does not describe or suggest all the limitations of the claimed invention and a prima facie case of obviousness has not been established. The Examiner is respectfully requested to withdraw the rejection of Claims 6-8, 11 and 12.

5. Applicants have again traversed the Examiner's restriction requirement, after electing Invention II and arguing against the restriction. Applicants thank the Examiner for finding allowable subject matter if claims are rewritten in independent format with all the limitations of the base claim and any intervening claims. Applicants have amended Claims 1 and 14 to better describe the invention and to correct informalities. Applicants further request that the Examiner withdraw rejections for anticipation and obviousness, and advance the claims to allowance.

Respectfully submitted,



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APPENDIX A

Marked-up version showing additions underlined and deletions in brackets:

1. (Amended twice) An integrated light and accessory assembly for a motor vehicle, comprising:

an insulator;

at least one reflector mounted on said insulator;

at least one conductor mounted on said insulator;

at least one lamp connected to said at least one conductor and assembled inside said at least one reflector;

at least one control module mounted on said insulator and connected to said at least one conductor; and

a housing, enclosing the insulator, the at least one reflector, the at least one conductor, the at least one lamp and the at least one control module,

wherein the lamp and the reflector are adapted to provide illumination, and [the conductor and] the control module [are adapted to receive electrical power] is adapted for controlling or supplying power to the at least one lamp.

14. (Amended twice) An integrated light and accessory assembly for a motor vehicle, comprising:

an insulator;

at least one reflector mounted to said insulator;

at least one conductor mounted to said insulator;

at least one lamp connected to said at least one conductor and assembled inside said at least one reflector;

an electronic module mounted on said insulator and connected to said at least one conductor; and

a housing, enclosing the insulator, the at least one reflector, the at least one conductor, the at least one lamp and the electronic module,

wherein the lamp and the reflector are adapted to provide illumination, and the [conductor and controller are adapted to receive electrical power] electronic module is adapted for controlling or supplying power to the at least one lamp.